

REMARKS

After entering the above amendments, claims 1-10 and 15-23 will be pending. Reconsideration and allowance of the current application are requested in light of the above-marked amendments and the foregoing remarks.

Summary of Claim Rejections. The Office has rejected claims 1-10 and 15-23 under 35 U.S.C. §103(a) as allegedly being unpatentably obvious over U.S. Pre-Grant Publication 2003/0204449 by Kotas *et al.* ("Kotas") in view of U.S. Patent 6,859,909 to Lerner *et al.* ("Lerner").

Summary of Amendments. With this amendment, claims 22 and 23 have been amended to enhance clarity. The amendments are fully supported by the original specification and have not changed in scope. No new matter has been added with this amendment.

Rejections under 35 USC §103

Claims 1-10 and 15-23 stand rejected under 103(a) as allegedly being unpatentable over Kotas in view of Lerner. This rejection is respectfully traversed. For a proper rejection under 35 U.S.C. §103(a), the Office "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness" and must therefore present "a clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP §2142. An obviousness rejection "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP §2141 quoting *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1386, 1385 (2007). This rationale must include a showing that all of the claimed elements were known in the prior art and that one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, to produce a combination yielding nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395. MPEP §2141.02 further notes that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540,

220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The rejections over Kotas and Lerner fail to satisfy this burden with regards to the currently pending claims.

With regards to claims 1, 15, 18, and 21, the Office has alleged that Kotas illustrates a user interface having several different controls, including a rectangular search box in the upper left corner of the interface, and that the search box presents a menu of predetermined search query options (or drill down query options for claim 15), such as "Music" or "Camera and Photo." The Office has acknowledged (see e.g. bottom of page 2 of the January 25, 2008 Office Action) that Kotas fails to disclose or suggest a predetermined visual configuration in the control. While Applicant appreciatively acknowledges this admission by the Office, it is respectfully submitted that the Office's analysis ignores an important additional element of claim 1 that was discussed during the interview of November 27, 2007 between the undersigned and Examiner Sam Rimell. Specifically, claims 1, 15, 18, and 21 explicitly require that each search option specifies and displays in the control both an associated predetermined query (or drill down query for claim 15) and an associated predetermined visual configuration for displaying results of the predetermined query. The analysis presented in the Office Action of January 25, 2005 makes no mention of this element. Rather, Lerner is proffered as a disclosure of a "view" menu that allows selection of views for the search results. While Applicant does not dispute that Lerner shows such a "view" menu, the Office has failed to provide any rationale to support the apparent assertion that one of ordinary skill in the art would have found a benefit in specifying both the query to be performed and the visual configuration with which to show the query results in a single search option among a plurality of such search options that are presented in a control. Applicant respectfully wonders whether the Office mistakenly failed to consider this element of claims 1, 15, 18, and 21 in conducting its search and constructing the pending rejections under 35 U.S.C. §103(a).

For further clarification of the issues raised above, the Office's attention is respectfully directed to control 204 shown, for example in FIG. 3 of the current application for an illustration of the subject matter recited in claims 1, 15, 18, and 21. The pending rejections of claims 1, 15, 18, and 21 fail to meet

the burden of providing a *prima facie* basis for the obviousness of the claimed subject matter at least for failing to explain why one of ordinary skill in the art would have found a reason to create control having search options as discussed above and shown in the drawings of the current application. For at least this reason, withdrawal of the rejections of claims 1, 15, 18, and 21 is respectfully requested.

Each of claims 2-10, 16, 17, 19-20, and 22-23 depends from one of the independent claims discussed above and therefore includes the elements discussed above. Based on the failure of Kotas and Lerner to form a proper *prima facie* case for obviousness of the independent claims, the dependent claims are likewise submitted to be patentable.

With regards to claims 2 and 3, the Office has failed to provide any rationale in support of its apparent contention that one of ordinary skill in the art would have found a benefit in creating a control with two search options having a common (the same) specified query but different visual configurations (as in claim 2) or with two search options having different specified queries but a common (the same) specified visual configuration. As such, no valid *prima facie* case for obviousness has been presented for these claims and the rejections should be withdrawn.

With regards to claims 22 and 23, Applicant submits that the meaning of the claims is not consistent with the Office's apparent interpretation of the claim scope. Based on the stated objections, it appears that the Office has interpreted "change" in the same manner as "select" is used in claims 1 and 15. The intended subject matter of claims 1 and 15 covers a prompt to a user that allows the user to customize the search options that are to be presented in the control, not to choose to a different search option from a control that offers a plurality of predetermined search options. To further prosecution in this manner, claims 22 and 23 have been amended slightly to clarify that the user is prompted to reconfigure one of the plurality of search options presented and displayed in the control so that a different query (or drill down query in claim 23) or different visual configuration is presented and displayed. Neither Kotas nor Lerner discloses or suggests these features. As such, at least the subject matter of claims 22 and 23 is patentable.


CONCLUDING COMMENTS

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

On the basis of the foregoing amendments, it is respectfully submitted that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. No fees are believed to be due, however the Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 34874-021/2003P00725US.

Respectfully submitted,

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